

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUO MATSUMURA,
KAZUHIKO YANAGIDA,
MANABU SERIZAWA,
HIDEKAZU YAGUCHI,
TSUTOMU KUBO,
and SHIGERU SEITOKU

MAILED

JUL 03 2007

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal 2007-1025
Application 10/658,811
Technology Center 1700

Oral Hearing Held: May 9, 2007

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and [FULL LINDA M. GAUDETTE, ⁰
Administrative Patent Judges

On Behalf of the Appellant:

RYAN CHRISTOPHER CADY, ESQ.
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1 The above-entitled matter came on for hearing on Wednesday,
2 May 9, 2007, commencing at 9:45 a.m. at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia.

4 CLERK: Calendar No. 18, Case No. 2007-1025. Mr. Ryan
5 Cady.

6 (Mr. Cady entering the hearing room.)

7 JUDGE TIMM: Good morning, Mr. Cady.

8 MR. CADY: Good morning, Your Honors.

9 JUDGE TIMM: Could you spell your last name for the record,
10 please?

11 MR. CADY: Yes. C-a-d-y.

12 JUDGE TIMM: And you have 20 minutes to present your
13 arguments. And you can assume that we understand the issues and the facts
14 of the case. And you may start when you're ready.

15 MR. CADY: Thank you very much. On appeal in this case are
16 essentially 102(b) and 103 rejections over the primary reference, which is
17 Tanaka. The application generally relates to improved toner compositions
18 and binder resins, which are well-known in the art.

19 And Tanaka has essentially been used to anticipate claim 1,
20 from which all other claims depend. And for that reason, we'd like to focus

1 the discussion today entirely on the 102(b) rejection over claim 1, using
2 Tanaka. The facts surrounding the Tanaka reference are so clear that we
3 believe that we can overcome all of the obvious rejections as well.

4 Essentially, in this case the examiner failed to establish the
5 prima facie case that Tanaka discloses the features of claim 1. The
6 examiner points to Tanaka's claim 11, which recites a co-polymer that is a
7 methyl methacrylate, isobutyl methacrylate, and methacrylic acid
8 co-polymer. That's true.

9 The problem with that analysis is that the isobutyl methacrylate
10 in Tanaka's claim 11 and the butyl methacrylate which we require, which
11 meet the limitations of our instant claim 1, are a different species. Claim 1
12 requires the butyl methacrylate because it has a glass transition point below
13 50 degrees, whereas the examiner assumes that the isobutyl methacrylate
14 has the same glass transition point.

15 But it doesn't. In actuality, the isobutyl form has a glass
16 transition of over 50 degrees. And so in that respect, the examiner clearly
17 failed in his -- to bear the initial burden of establishing a prima facie case
18 for anticipation.

1 JUDGE SMITH: As a point of clarity, when you refer to Tg
2 monomer, you're meaning a polymer produced from that monomer having
3 that Tg point?

4 MR. CADY: If I can refer to our claim, the claim
5 specifically -- the way it's stated is that the toner comprises as a main
6 component of binder resin, that the binder resin has a copolymer consisting
7 of three monomers, so the monomer 1, 2, and 3. The first monomer is the
8 high Tg monomer.

9 JUDGE SMITH: Monomers don't have transition glass
10 temperatures, usually. That's why I'm asking for a point of clarification.

11 MR. CADY: Without -- well, I won't make any statements
12 about broad chemistry in general. But certainly here you can -- we've even
13 in fact done a search result for these monomers. And I'd like to talk about
14 that in a second. But in this case, the monomers in our specification that we
15 recite and that are also recited in Tanaka claim 11 each have -- or the first
16 two, at least -- have a glass transition temperature.

17 JUDGE SMITH: What's the molecular weight of your
18 monomer?

19 MR. CADY: I believe it's in the range that the examiner cites,
20 which is around -- I'd have to read the specification. I'm not prepared to

1 answer exactly what the weight is, although we don't traverse the examiner's
2 assertion that it does have a -- his assumed molecular weight in his answer.
3 If I may?

4 JUDGE SMITH: So what evidence do you have that the
5 monomers listed in the claim 11 of Tanaka don't meet your claim, then?
6 Didn't he produce that on the record?

7 MR. CADY: It's not clear we traverse the examiner's assertion
8 that he's met the prima facie case. We didn't plainly and simply say that the
9 isobutyl form has a different glass transition temperature. I'm not sure why.
10 I also don't know why the examiner didn't take the .8 seconds that it
11 required for us to do the search to make the same determination.

12 We've got those here for your convenience, if you're interested
13 at all. There are over 100,000 results. Literally the first document that we
14 pulled has a glass transition temperature of both the isobutyl methacrylate
15 and the normal butyl methacrylate.

16 JUDGE TIMM: Well, if that evidence wasn't before the
17 examiner, I don't think it would be appropriate for us to look at it now.

18 MR. CADY: That's fine. Would the board be interested in
19 taking judicial notice of that fact, being that it's --

20 JUDGE SMITH: No.

1 MR. CADY: -- readily available and widely accepted?

2 JUDGE SMITH: No.

3 JUDGE TIMM: No. We would like to be able to have the
4 examiner's input before we would make a determination like that since it
5 wasn't discussed in the record.

6 MR. CADY: Okay. That being said, that's essentially what the
7 issue here is, as we see it, is that the examiner failed in that respect to do the
8 requisite work in order to make -- to establish the prima facie case of
9 anticipation because in fact, one of the monomers listed in Tanaka's claim
10 11 simply doesn't meet the limitations of our claim 1. And having overcome
11 Tanaka, we then --

12 JUDGE SMITH: Okay. Let's back up for a second just to
13 clarify your record. You're saying the isobutyl methacrylate has a Tg of
14 what?

15 MR. CADY: Fifty-three.

16 JUDGE SMITH: And the other monomer -- okay. For that
17 matter, give us all three Tgs. The methyl methacrylate is?

18 MR. CADY: Methyl methacrylate? I don't have -- I've got
19 isobutyl methacrylate and butyl methacrylate. We don't contest that methyl

1 methacrylate and the hydrophilic monomer that the examiner cites are
2 within the ranges. We accept that.

3 JUDGE SMITH: What's your Tg for butyl methacrylate?

4 MR. CADY: Twenty. So it's beneath 50 degrees, and it
5 qualifies in our specification and in our claim as a low Tg monomer.

6 JUDGE SMITH: But according to claim 11, you have a methyl
7 methacrylate, an isobutyl methacrylate, and a methacrylic acid copolymer.

8 MR. CADY: Claim 11 of Tanaka, Your Honor?

9 JUDGE SMITH: Yes. Yes.

10 MR. CADY: That's right. And the --

11 JUDGE SMITH: And then according to paragraph 40 of your
12 specification -- let's see.

13 MR. CADY: That's exactly right.

14 JUDGE SMITH: So you're saying both methyl methacrylate
15 and the isobutyl methacrylate both were high Tg monomers?

16 MR. CADY: Yes. The examiner uses -- if you look at claim
17 11, the middle monomer there is the isobutyl methacrylate. That, according
18 to our claim limitations, needs to be a low Tg monomer. The examiner
19 looks at the examples of our low Tg monomers and equates the isobutyl

1 form in Tanaka with the butyl methacrylate that we list, which is -- those are
2 separate species and they have different properties.

3 In our specification, you can see that we treat iso -- I think in
4 paragraph 45, there's a specific example of a high Tg monomer that's the iso
5 form. And throughout other parts of the specification, we truly -- we clearly
6 treat the iso form as different than the normal form of these monomers. And
7 I think that's also well-established in the art.

8 JUDGE GAUDETTE: But you never raised that argument
9 during prosecution?

10 MR. CADY: It doesn't seem that it was raised specifically. It
11 seems that they simply argued that the prima facie case hadn't been met. I
12 don't know why they didn't take the extremely brief amount of time it takes
13 to determine that, or why the examiner didn't meet his burden in that
14 respect.

15 JUDGE TIMM: Is there another argument that is on the record
16 that you'd like to have us consider?

17 MR. CADY: All the arguments relating to -- certainly relating
18 to obviousness, but also relating to the general thrust of Tanaka having been
19 directed toward a styrenic compound, clearly the examples in Tanaka, both
20 examples and the entire disclosure, teaches away from in all respects using

1 our compound, in the sense that throughout our specification teach away
2 from using styrene for all of the detriments in its entirety. And I think those
3 arguments are clearly briefed.

4 JUDGE TIMM: But is there an argument that claim 11 in the
5 reference doesn't anticipate?

6 MR. CADY: There is -- well, we don't concede in any sense
7 that claim 11 anticipates. And clearly, with this, what I'm arguing now -- if
8 I understand your question -- what I'm arguing now is simply clearly that
9 claim 11 does not anticipate.

10 JUDGE TIMM: But of your arguments on the record?

11 MR. CADY: Our arguments on the record don't concede that
12 claim 11 anticipates. They don't seem to traverse on the same grounds, as
13 far as I can tell. They do only in the general sense that we say that the
14 examiner hasn't made out a *prima facie* case. We don't specifically say that
15 this butyl methacrylate is actually a low Tg monomer whereas the isobutyl
16 form is a higher --

17 JUDGE SMITH: In fact, on page 12, first paragraph of your
18 brief, you seem to say that it -- you seem to acknowledge that it does meet
19 your claim, but argue further that there are no examples shown in this
20 particular species.

1 MR. CADY: We say that Tanaka's claim 11 indicates, and we
2 there -- I guess we recite exactly what Tanaka recites. But we would argue
3 that that's not a concession. That's simply a recitation of what Tanaka
4 actually recites. We know, and ordinarily skilled artisans know, that the
5 isobutyl form is different from the butyl methacrylate.

6 JUDGE SMITH: But how does that correspond to the
7 following, taken from that same paragraph: "Nor does Tanaka indicate that
8 these monomers are so chosen that a high Tg monomer, a low Tg monomer,
9 and a hydrophilic monomer are included in the copolymer"?

10 MR. CADY: Well, I think that's -- it's got to be a logical
11 conclusion because certainly the isobutyl form isn't a low Tg monomer.
12 And so Tanaka couldn't indicate that the monomers were chosen for those
13 reasons.

14 JUDGE SMITH: Okay. You can go on.

15 MR. CADY: Those are primarily the arguments that we'd like
16 to bring up, in addition to everything that's been briefed, as to the other --
17 the general notion that Tanaka teaches directly away from our claimed
18 invention, that it's examples and its entire disclosure is directed towards
19 styrene-containing compounds.

1 Essentially -- well, in addition to that, you would say that an
2 ordinarily skilled artisan looking at Tanaka, being that it's entirely directed
3 towards styrene-containing compounds, wouldn't have been motivated or
4 there would be no suggestion to have combined Tanaka with any of the
5 secondary references in order to obtain the claimed features.

6 And having said that, we don't believe that Tanaka alone does.
7 And so, essentially, all the obviousness rejections would fall as well.

8 JUDGE TIMM: Do you have any other arguments?

9 MR. CADY: No, Your Honor, I don't. If I may ask again that
10 the board take official notice of the fact that the isobutyl form has a different
11 glass transition than the butyl form of methacrylate. And that's all I've got.

12 JUDGE TIMM: Okay. I think we understand your position.

13 Judge Gaudette, Judge Smith, do you have any more questions?

14 JUDGE SMITH: No.

15 JUDGE GAUDETTE: No.

16 MR. CADY: Very good. Thank you.

17 (Whereupon, at 9:58 a.m., the appeal was concluded.)